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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,784	10/20/2000	Arturo A. Rodriguez	A-6690	8546

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
5030 SUGARLOAF PARKWAY  
LAWRENCEVILLE, GA 30044

EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/693,784	<b>Applicant(s)</b> RODRIGUEZ ET AL.	
	<b>Examiner</b> Scott Beliveau	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 83-108 is/are pending in the application.
- 4a) Of the above claim(s) 87-95 and 100-108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-86 and 96-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 87-95 and 100-108 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 17 February 2004.

### *Priority*

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,978) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112. In particular, the provisional application generally discloses that the user may select a video program and to further receive a reminder when that program becomes available. The provisional application, however, fails to disclose the particular presentation method of the available video presentations that are not currently available such that it is necessarily presented in a "list" as claimed. The only recitation of the particular method for presenting the available presentation discloses the ability of a user to select from the programs from a variety of promotional programs such as a barker channel (Full Motion Video – Page 5). Furthermore, there is no disclosure as to the particular details as to how the reminder is provided as set forth in claims 84-86 and 88-90.
3. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,488, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-3) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application

pertaining to the adding of a selected media title to a “reminder” list does not appear to be supported in the parent application. Accordingly, elected claims 83-86 and 96-99 of the instant application shall be examined in view of the filing date or 19 October 2000.

***Response to Arguments***

4. Applicant's arguments with respect to newly presented claims 83-86 and 96-99 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 83-86 and 96-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pub No. 2004/0117831).

In consideration of claims 83 and 96, the Ellis et al. reference discloses “television set-top terminal” [26] comprising “memory configured to store program code” [26] and a “processor” (not shown) so as to implement a method for facilitating providing reminders for upcoming presentations for rent (§ [0098] – [0101]). As illustrated in connection with Figure 11, the system “provides a list of video presentations that are not currently available for rent” [192]. The system may subsequently, “receive viewer input configured to select one of the

video presentations from the list of video presentations” and “provide reminder information to the viewer after the selected video presentation becomes available for rent via the STT . . . to remind the viewer that the selected video presentation has become available for rent via the STT” (§ [0133] – [0134]). Arguably, the Ellis et al. is unclear as to the particular association and generation of a “reminder list” in connection with the unavailable programming as the illustrated example of a “reminder list” is illustrated in connection with a personalized schedule of programs (Figure 20; § [0150] – [0151]). Rather, such details are more clearly set forth and illustrated in the McKissick et al. application expressly incorporated by reference (§ [0134]).

The McKissick et al. application describes further details pertaining to the method for providing a user with a list of video presentations that are not currently available and to notify individuals that have requested to be reminded of such programming once it becomes available (Page 2, Lines 25-33; Page 3, Lines 13-26). The “selected video presentations” for which reminders are requested are stored associated with “a reminder list” (Page 16, Lines 11-26).

Claims 84 and 97 are rejected wherein the system “provides reminder information . . . responsive to viewer input requesting access to the reminder list” such that subsequent to accessing a “reminder list” (Figure 5) the user is able to access “reminder information” pertaining to the newly available program (Page 18, Line 1 – Page 14)

Claims 85 and 98 are rejected wherein subsequent to a program becoming available the program aforementioned selected program becomes an in-frame program which is displayed

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normally within the program guide thereby "providing reminder information . . . responsive to viewer input requesting access to the a list of presentations currently available for rent".

Claims 86 and 99 are rejected wherein Figure 12 of the McKissick et al. reference illustrates that the "step of providing reminder information is performed via a barker".

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The Boyer et al. (US Pub No. 2002/0026496) reference discloses a system and method for establishing flexible program reminders.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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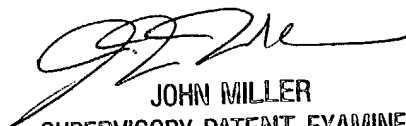
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
October 16, 2004

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600